

REMARKS

This response is made four months from the date of the Office Action of December 18, 2002, and a one month extension fee is included herein. As a result of this amendment, claims 1-2, 10-13, 15, and 17-18 have been amended, claims 14 and 16 have been canceled, and new claim 20 is now presented.

Claim Rejections -- 35 USC §102

Anticipation can only be established by a single prior art reference which discloses each and every element of the claimed invention. *Structural Rubber Products Co., v. Park Rubber Co.*, 749 F.2d 7070; 223 U.S.P.Q. 1264 (C.A.F.C. 1984). The test for anticipation requires that all of the claimed elements must be found in exactly the same situation and united in the same way to perform the same function in a single unit of the prior art. *Studiengesellschaft Kohle, m.b.H. v. Dart Industries., Inc.*, 762 F.2d 724, 726, 220 U.S.P.Q. 841 at 842 (C.A.F.C. 1984). Anticipation cannot be predicated on teachings in a reference that are vague or based on conjecture. *Datascope Corp. v. SMEC Inc.*, 594 F. Supp. 1036; 224 U.S.P.Q. 694, 698 (D.N.J. 1984).

The Examiner has rejected claims 1-3, 5, and 10-19 under 35 USC §102(a) as being anticipated by Popcock U.S. patent No. 6,314,577. The applicant traverses the Examiner's position for at least the following reasons.

Claim 1- Claim 1, as amended, requires the steps of providing a portable recording device, recording data related to a music item playing on a radio using said portable recording device, and transmitting said data from said portable recording device to a music identification/purchasing system. Popcock '577 does not disclose the portable recording device of claim 1, as amended.

Claim 10 – Claim 10, as amended, requires the steps of providing a portable communication

device, transmitting a segment of music playing on a radio to a music identification/purchasing system using said portable communication device. Popcock '577 does not disclose the portable communications device of claim 10, as amended.

Claim 13-Claim 13, as amended, requires the steps of providing a portable communication device, recording a segment of music playing on a radio using said portable communication device, and transmitting said recorded musical segment from said portable communication device into a central processing unit. Popcock '577 does not disclose the portable communications device of claim 13, as amended.

Claim 15-Claim 15, as amended, requires a means for receiving an audio playback of a selected musical work from a portable communications device. Popcock '577 does not disclose the portable communications device of claim 15, as amended.

Claims 2, as amended, 3, 5, 11, as amended, 12, 17, as amended 18, as amended, and 19 depend from one of the independent claims listed above which are now believed to be in an allowable condition, and therefore the dependent claims are also believed to be in an allowable condition.

Popcock '577 does not involve the step of recording data related to the music item playing on the radio. Popcock '577 requires a program schedule from a local radio station. Accordingly, the user must know the station that the radio is set to. This is often impossible when the song is being played over a private system such as in a restaurant, club, elevator, etc.

Claim Rejections -- 35 USC §103

According to the MPEP, section 2143, the Examiner must establish three basic criteria to form a *prima facie* rejection based on obviousness. First, there must be some suggestion or motivation, either in the knowledge generally available or to one of ordinary skill in the art to modify the reference or to combine the reference teachings. Second, there must be some reasonable expectation of success. Third, the prior art reference (or references when combined)

must teach or suggest all the claimed limitations.

In re Fine, 837 F.2d 1071, 350, 5 USPQ 2d 1596 (C.A.F.C. 1992) states:

“The PTO has the burden under section 103 to establish a *prima facie* case of obviousness. *See In re Piasecki*, 745 F 2d 1468, 1471-72, 223 USPQ 785 (Fed. Cir. 1984). It can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. *In re Lalu*, 747 F.2d 703, 705; 223 USPQ 1257, 1258 (Fed. Cir. 1984) ... [Other references omitted] ... This it has not done. The Board points to nothing in the cited references, either alone or in combination, suggesting or teaching Fine’s invention.”

And further:

“Obviousness is tested by “what the combined teachings of the references would have suggested to those of ordinary skill in the art”. *In re Keller*, 642 F.2d 413; 208 USPQ 871 (CCPA 1981). But it “cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination”. *ACS Hosp. Sys.*, 732 F.2d at 1577, 221 USPQ at 933. And “teachings of references can be combined only if there is some suggestion or incentive to do so.” *Id.* Here, the prior art contains none.”

The Examiner has rejected claims 4, and 6-9 under 35 USC §103(a) as being unpatentable over Popcock in view of Official Notice. The applicant traverses the Examiner’s position for at least the following reasons.

Claims 4, and 6-9 from independent claim 1, as amended, which is now believed to be in an allowable condition, and therefore the dependent claims are also believed to be in an allowable condition.

Claim 20

Claim 20 is newly presented and is closely related to claim 12, as amended, and requires a music to music comparison of the transmitted music in the analysis/identification step. In addition, the music can be directly transmitted from the portable communications device to the music identification system. This enables identification when other information may not be available, i.e.

music station, play lists, etc. It is believed that this claim is distinguished over the prior art of record and is an allowable claim.

In view of the claim amendments and of the arguments set forth above, prompt reconsideration and allowance of the claims is earnestly requested.

Respectfully submitted,
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